

REMARKS/ARGUMENTS

I. General Remarks.

Applicants respectfully request that the above amendments be entered and further request reconsideration of the application in view of the amendments and the remarks contained herein.

II. Disposition of the Claims.

Claims 1-41 are pending. Claims 1-34 stand rejected.

Claims 1, 3, 5-7, 9, 11-12, 14, 18, 20, 22-24, 26, 28-29, and 31 are amended herein. All the above amendments are made in a good faith effort to advance the prosecution on the merits of this case. Applicants reserve their rights to take up prosecution on the claims as originally filed in this or an appropriate continuation, continuation-in-part, or divisional application.

Claims 36-41 are new. Applicants respectfully assert that claims 36-41 are novel and nonobvious, and earnestly solicit a timely Notice of Allowance for these claims.

Due to the inadvertent omission of claim 32 in the Application as filed, the Examiner noted that the numbering of the claims in this Application as filed is not in accordance with 37 C.F.R. § 1.126. For examining purposes, the Examiner noted that misnumbered claims 33, 34, and 35 have been renumbered 32, 33, and 34, respectively. For the purposes of this Response, Applicants refer to misnumbered claims 33, 34, and 35 as those claims have been renumbered by the Examiner.

III. Remarks Regarding Amendments to the Specification.

Paragraphs [014], [015], [021], and [024] have been amended to correct inadvertent typographical errors.

IV. Remarks Regarding Claim Objections.

The Examiner has objected to claims 6-7, 11, 23-24, and 28 “because of the following informalities: tackyfier is misspelled.” (Office Action at 2.) Applicants have amended these claims to correct this informality. Accordingly, Applicants respectfully request the removal of this objection with respect to claims 6-7, 11, 23-24, and 28.

The Examiner has objected to claim 5 “because of the following informalities: claim 5 is dependent upon claim 7.” (Office Action at 2.) Applicants have amended this claim

to correct this informality. Accordingly, Applicants respectfully request the removal of this rejection with respect to claim 5.

V. Remarks Regarding Rejections Under 35 U.S.C. § 102.

The Examiner has rejected claims 1, 6-8, 10-11, 18, 23-25, and 27-28 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,209,643 issued to Nguyen et al. ("*Nguyen '643*"). Applicants respectfully traverse.

Regarding *Nguyen '643*, the Examiner states:

With respect to claims 1 and 18: [*Nguyen '643*] teaches in column 9, lines 12 – 18 a method of controlling fines migration in a subterranean formation comprising the steps of: (a) placing a tackifying composition into the subterranean formation; and (b) placing an after-flush fluid into the subterranean formation.

(Office Action at 3.)

To anticipate a claim, a reference must teach or suggest each and every claim limitation. *Manual of Patent Examining Procedure* § 2131 (8th ed., rev. 2, May 2004) (hereinafter "MPEP"). Since *Nguyen '643* does not teach or suggest each and every limitation of claims 1, 6-8, 10-11, 18, 23-25, and 27-28, Applicants respectfully submit that it does not anticipate these claims.

In particular, independent claims 1 and 18 as amended recite the step of "placing a tackifying composition into the subterranean formation so as to form a coating on one or more particulates present in the subterranean formation, wherein the one or more particulates were present in the subterranean formation prior to the placement of the tackifying composition therein." However, *Nguyen '643* does not teach forming a coating on particulates present in a subterranean formation. In pertinent part, *Nguyen '643* provides that:

[A] method of treating a subterranean formation penetrated by a wellbore is provided comprising the steps of providing a fluid suspension including a mixture of a particulate material, a material comprising a liquid or solution of a tackifying compound, *which coats at least a portion of the particulate upon admixture therewith* . . . pumping the fluid suspension including the coated particulate . . . through the wellbore and depositing the mixture in the formation.

(*Nguyen '643*, Col. 3 ll. 36-49.) (emphasis added.) Thus, rather than disclosing the step recited in claims 1 and 18, *Nguyen '643* discloses that the tackifying compound coats particulate

material with which the tackifying compound is admixed. (*Nguyen* '643, Col. 3, ll. 36-49.) *Nguyen* '643 thus does not teach or suggest the step of placing a tackifying composition into the subterranean formation so as to form a coating on one or more particulates present in the subterranean formation, wherein the one or more particulates were present in the subterranean formation prior to the placement of the tackifying composition therein as recited in independent claims 1 and 18 as amended.

Therefore, Applicants respectfully assert that independent claims 1 and 18 are not anticipated by *Nguyen* '643. The remaining claims depend either directly or indirectly on these independent claims. All these dependent claims, which include all the limitations of their corresponding independent claims, are allowable for at least the reasons cited above with respect to independent claims 1 and 18. Accordingly, the Applicants respectfully request withdrawal of this rejection with respect to claims 1, 6-8, 10-11, 18, 23-25, and 27-28.

VI. Remarks Regarding Rejections Under 35 U.S.C. § 103.

A. Claims 2-5 and 19-22 Are Not Obvious Over *Nguyen* '643 in View of *Bannister*.

The Examiner has rejected claims 2-5 and 19-22 under § 103(a) as being obvious over *Nguyen* '643 in view of U.S. Patent No. 4,681,165 issued to Charles E. Bannister ("*Bannister*"). Applicants respectfully traverse.

To establish a *prima facie* case of obviousness, the cited references must teach or suggest each and every claim limitation. See MPEP 2142. Since the combination of *Nguyen* '643 and *Bannister* does not teach or suggest each and every claim limitation, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to claims 2-5 and 19-22. See MPEP § 2142.

Claims 2-5 and 19-22 depend either directly or indirectly from independent claim 1 or 18. As amended, independent claims 1 and 18 recite the step of "placing a tackifying composition into the subterranean formation so as to form a coating on one or more particulates present in the subterranean formation, wherein the one or more particulates were present in the subterranean formation prior to the placement of the tackifying composition therein." As discussed above with respect to the § 102(b) rejection, *Nguyen* '643 does not disclose teach or suggest this limitation. Nor can *Bannister* be used to supply this missing limitation. Therefore, independent claims 1 and 18 are not obvious over *Nguyen* '643 in view of *Bannister*. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is

nonobvious.” See MPEP § 2143.03. Accordingly, dependent claims 2-5 and 19-22 are not obvious over *Nguyen* ‘643 in view of *Bannister*, and thus withdrawal of this rejection with respect to these claims is respectfully requested.

B. Claims 12-14 and 29-31 Are Not Obvious Over *Nguyen* ‘643 in View of *Gilmour*.

The Examiner has rejected claims 12-14 and 29-31 under § 103(a) as being obvious over *Nguyen* ‘643 in view of U.S. Patent No. 6,534,449 issued to Gilmour et al. (“*Gilmour*”). Applicants respectfully traverse.

To establish a *prima facie* case of obviousness, the cited references must teach or suggest each and every claim limitation. See MPEP 2142. Since the combination of *Nguyen* ‘643 and *Gilmour* does not teach or suggest each and every claim limitation, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to claims 12-14 and 29-31. See MPEP § 2142.

Claims 12-14 and 29-31 depend either directly or indirectly from independent claim 1 or 18. As amended, independent claims 1 and 18 recite the step of “placing a tackifying composition into the subterranean formation so as to form a coating on one or more particulates present in the subterranean formation, wherein the one or more particulates were present in the subterranean formation prior to the placement of the tackifying composition therein.” As discussed above with respect to the § 102(b) rejection, *Nguyen* ‘643 does not disclose teach or suggest this limitation. Nor can *Gilmour* be used to supply this missing limitation. Therefore, independent claims 1 and 18 are not obvious over *Nguyen* ‘643 in view of *Gilmour*. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” See MPEP § 2143.03. Accordingly, dependent claims 12-14 and 29-31 are not obvious over *Nguyen* ‘643 in view of *Gilmour*, and thus withdrawal of this rejection with respect to these claims is respectfully requested.

C. Claims 9, 16-17, 26, and 33-34 Are Not Obvious Over *Nguyen* ‘643 in View of *Nguyen* ‘878.

The Examiner has rejected claims 9, 16-17, 26, and 33-34 under § 103(a) as being obvious over *Nguyen* ‘643 in view of U.S. Patent No. 5,960,878 issued to Nguyen et al. (“*Nguyen* ‘878”). Applicants respectfully traverse.

To establish a *prima facie* case of obviousness, the cited references must teach or suggest each and every claim limitation. See MPEP 2142. Since the combination of

Nguyen '643 and *Nguyen* '878 does not teach or suggest each and every claim limitation, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to claims 9, 16-17, 26, and 33-34. *See* MPEP § 2142.

Claims 9, 16-17, 26, and 33-34 depend either directly or indirectly from independent claim 1 or 18. As amended, independent claims 1 and 18 recite the step of "placing a tackifying composition into the subterranean formation so as to form a coating on one or more particulates present in the subterranean formation, wherein the one or more particulates were present in the subterranean formation prior to the placement of the tackifying composition therein." As discussed above with respect to the § 102(b) rejection, *Nguyen* '643 does not disclose teach or suggest this limitation. Nor can *Nguyen* '878 be used to supply this missing limitation. Therefore, independent claims 1 and 18 are not obvious over *Nguyen* '643 in view of *Nguyen* '878. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *See* MPEP § 2143.03. Accordingly, dependent claims 9, 16-17, 26, and 33-34 are not obvious over *Nguyen* '643 in view of *Nguyen* '878, and thus withdrawal of this rejection with respect to these claims is respectfully requested.

D. Claims 15 and 32 Are Not Obvious Over *Nguyen* '643 and *Bannister* in View of *Nguyen* '878.

The Examiner has rejected claims 15 and 32 under § 103(a) as being obvious over *Nguyen* '643 and *Bannister* in view of *Nguyen* '878. Applicants respectfully traverse.

To establish a *prima facie* case of obviousness, the cited references must teach or suggest each and every claim limitation. *See* MPEP 2142. Since the combination of *Nguyen* '643, *Bannister*, and *Nguyen* '878 does not teach or suggest each and every claim limitation, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to claims 15 and 32. *See* MPEP § 2142.

Claims 15 and 32 depend either directly or indirectly from independent claim 1 or 18. As amended, independent claims 1 and 18 recite the step of "placing a tackifying composition into the subterranean formation so as to form a coating on one or more particulates present in the subterranean formation, wherein the one or more particulates were present in the subterranean formation prior to the placement of the tackifying composition therein." As discussed above with respect to the § 102(b) rejection, *Nguyen* '643 does not disclose teach or suggest this limitation. Nor can *Nguyen* '878 or *Bannister* be used to supply this missing limitation. Therefore, independent claims 1 and 18 are not obvious over *Nguyen* '643 and

Bannister in view of *Nguyen* '878. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." See MPEP § 2143.03. Accordingly, dependent claims 15 and 32 are not obvious over *Nguyen* '643 and *Bannister* in view of *Nguyen* '878, and thus withdrawal of this rejection with respect to these claims is respectfully requested.

SUMMARY

In light of the above remarks and amendments, Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

The Commissioner is hereby authorized to debit the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300 (Reference Number HES 2003-IP-010303U1) in the amount of \$300 under 37 C.F.R. § 1.16(i) for the new claims presented herein. Applicants believe that no additional fees are due in association with the filing of this response. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300 (Reference Number HES 2003-IP-010303U1) for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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Date: September 16, 2005